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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,516	03/01/2002	Cliff Roth	GIST-005/01US	4083
22903	7590	03/04/2005	EXAMINER	
COOLEY GODWARD LLP ATTN: PATENT GROUP 11951 FREEDOM DRIVE, SUITE 1700 ONE FREEDOM SQUARE- RESTON TOWN CENTER RESTON, VA 20190-5061				LEROUX, ETIENNE PIERRE
ART UNIT		PAPER NUMBER		
		2161		
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/087,516	ROTH ET AL.
	Examiner Etienne P LeRoux	Art Unit 2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 December 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 March 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

***Status of the Claims***

Claims 1-27 are pending. Claims 1-27 are rejected.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites “wherein the restricted program indicators correspond to program indicators included in the list of recommended program indicators.” The scope of the invention cannot be determined because it is difficult to determine how a program indicator can simultaneously be restricted and recommended.

Claim 4 recites “wherein at least one of the program indicators included in the list of preferred program indicators is not included in the list of recommended programs.” The scope of the invention cannot be determined because the difference, if any, between a preferred program and a recommended is not clear.

***Art Rejection Precluded***

Claims 3 and 4 are rejected under 35 U.S.C. 112, first and second paragraphs, as being indefinite and lacking enablement. No art rejection of claims 3 and 4 is provided in this office action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-8 and 10-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,781,246 issued to Alten et al (hereafter Alten), as best examiner is able to ascertain.

**Claims 1, 5 and 19:**

Alten discloses a method for generating an electronic program listing recommendation guide [abstract], the method comprising:

- receiving a request from a user to generate a recommendation guide [col 26, lines 35-43];
- retrieving category preferences associated with the user [movies, news, sports or children's shows, Fig 8, 83, col 26, lines 34-43];
- retrieving a list of restricted program indicators [parental guidance 301, Fig 30, col 20, lines 9-33];

- retrieving a list of preferred program indicators [viewer preference mode 161, Fig 16, col 19, lines 49-57];
- retrieving a list of recommended program indicators [favorite channel 71, Fig 7], the program indicators included in the list of recommended program indicators corresponding to at least one of the retrieved category preferences;
- generating a list of displayable program indicators [Fig 19, col 16, lines 52-67], wherein the list of displayable program indicators includes program indicators included in the list of preferred program indicators and program indicators included in the list of recommended program indicators but not included in the list of restricted program indicators [key lock, col 20, lines 16-23];
- displaying program indicators [Fig 19, col 16, lines 52-67] included in the generated list of displayable program indicators, wherein the displayed program indicators are arranged according to the retrieved category preferences.

Claim 2:

Alten discloses transmitting the generated list of displayable program indicators to a set-top box associated with the user [col 7, lines 30-40].

Claim 6:

Alten discloses displaying the retrieved program data for a first program indicator included in the list of displayable program indicators, wherein the retrieved program data for the first program indicator is displayed in association with a first category included in the plurality of

category preferences, wherein the first category corresponds with the first program indicator [Fig 19, col 20, lines 52-67].

Claim 7:

Alten discloses displaying the retrieved program data for a second program indicator included in the list of displayable program indicators, wherein the retrieved program data for the second program indicator is displayed in association with a first category included in the plurality of category preferences, wherein the second category corresponds with the second program indicator [Fig 19, col 20, lines 52-67].

Claim 8:

Alten discloses displaying the first program indicator and an indicator of the first category in a first column; and displaying the second program indicator and an indicator of the second category in a second column [Fig 19].

Claims 10 and 20:

Alten discloses wherein the list of displayable program indicators comprises a list of recommended programs [Fig 18].

Claims 11 and 21:

Alten discloses receiving the list of recommended programs from a remote source [Fig 18].

Claims 12 and 22:

Alten discloses identifying a restricted program indicator, the restricted program indicator being selectable by the user; wherein the list of displayable program indicators does not include the restricted program indicator [key lock, col 20, lines 16-23].

Claims 13 and 23:

Alten discloses removing the restricted program indicator from the list of displayable programs [col 20, lines 41-45].

Claims 14 and 24:

Alten discloses identifying a preferred program indicator, the preferred program indicator being selectable by the user, wherein the list of displayable program indicators includes the preferred program indicator [viewer preference mode 161, Fig 16, col 19, lines 49-57].

Claims 15 and 25:

Alten discloses adding the preferred program indicator to the list of displayable programs indicators [viewer preference mode 161, Fig 16, col 19, lines 49-57].

Claims 16 and 26:

Alten discloses identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and removing the target program indicator from the list of displayable program indicators [col 26, lines 33-34].

Claims 17 and 27:

Alten discloses identifying a previously viewed program, the previously viewed program being associated with a target program indicator; locating the target program indicator in the list of displayable program indicators; and assigning a low display priority to the target program indicator included in list of displayable program indicators [revise schedule, col 19, lines 49-57].

Claim 18:

Alten discloses wherein the plurality of category preferences are customizable by the user [revise schedule, col 19, lines 49-57].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alten, as best examiner is able to ascertain..

Claim 9:

Alten discloses the elements of claims 5-7 as noted above.

Alten fails to disclose displaying the first program indicator and an indicator of the first category in a first row; and displaying the second program indicator and an indicator of the second category in a second row. It is noted that displaying the first program indicator and an indicator of the first category in a first row; and displaying the second program indicator and an indicator of the second category in a second row is well-known and expected in the art because a user typically finds it easy to read from top to bottom. The skilled artisan would have been motivated to modify the invention of Alten per the above such that data can be presented in a art recognized database format.

***Response to Arguments***

Applicant's arguments filed 12/3/2004 have been fully considered but they are not persuasive.

**Applicant Argues:**

Applicant states in the last paragraph of page 10 that "Preferred program indicators and recommended program indicators are different. This difference is set forth in the specification in, for example, paragraphs 9, 25, 26 and 27. Applicants submit that these paragraphs resolve all of the 112, second paragraph rejections.

**Examiner Responds:**

Examiner is not persuaded. MPEP § 2111.01 requires that during examination claims be interpreted as broadly as their terms reasonable allow. This means that words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. Examiner maintains that above statement by applicant that preferred program indicators and recommended program indicators are different, such differences being explained in paragraphs 9, 25, 26 and 27 does not constitute a clear definition. Therefore, examiner will give recommended program indicators and preferred program indicators their plain meaning. Recommend is defined as "to suggest favorably as suited for some use function position etc and preferred is defined as "to put before something or someone else in one's liking, opinion."<sup>1</sup>

Alten discloses in column 11, lines 1-13 the following:

The embodiment of the remote controller shown in FIG. 4 also includes three color-coded viewer preference or favorite channel keys, 48A, 48B and 48C that are situated directly above the icon keys. Each of these keys indicates to the program schedule system a distinct user-created "Channel Preference" or "Favorite Channel" list, which is a listing of a specific subset of channels for a particular user, arranged in the sequential order that the user wishes to view during operation of the program schedule system. The creation of the Channel Preference or Favorite Channel list is discussed in the following section. Thus, the system provides for at least three individual channel subsets for three individual users.

Alten discloses per the above that a user is able to customize a program schedule system (reads on the claimed recommended program schedule) provided by a service provider. Such customization enables the user to create a channel preference or favorite channel list. As best

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<sup>1</sup> Webster's New World College Dictionary. Fourth Edition

examiner is able to ascertain, above channel favorite list reads on the claimed preferred program indicator.

Alten discloses in column 26, line 44 through column 27, line 8 the following:

Once the user has revised the channel preference list 81 in the described manner, the microcontroller 16 will follow the stored user-specified channel sequence in response to a change-channel command made by the user employing one of the direction arrow keys. To activate the viewer preference list, the user depresses one of the three check-mark icon keys 48A, 48B or 48C on the top of the remote controller shown in FIG. 4. The viewer preference list can be used to selectively limit tuning of the television receiver or display of schedule information in any of the operating modes of the electronic program guide. In the present embodiment, once a preference list is activated, the system will limit the tuning of the television receiver and the display of schedule information in the FLIP, and BROWSE modes, as well as in the grid category and channel listings in the MENU mode, only to those channels designated in the activated viewer preference list. The tuner can not be tuned to, and no corresponding schedule information can be displayed for, any channel not entered in the viewer preference list when it is activated. In this regard, it should be noted that setting a key lock access in the Parental Guidance 301, MPAA 308 or Channel Block 303 categories produces a different result than when using other display criteria, such as the Channel Preference List of preferred channels discussed above. Thus, while a key lock access will prevent audio and video program information, but not schedule information, from being displayed or ordered absent entry of an authorization code, if a particular channel is included in the Channel Preference list and also has a key lock access activated in the Channel Block category 303 of the Key Lock Access mode, that channel or its corresponding schedule information will not be displayed at any time.

Alten discloses per the above that a user is able to activate a viewer preference list (reads on preferred program indicator) which can be used to selectively limit tuning of the television display of schedule information (reads on recommended program indicator). Examiner maintains Alten reads on recommended program indicator and preferred program indicator.

Alten discloses in column 30, lines 1-23 the following:

In addition to blocking all non-selected content-specific programming when a particular content-specific category has been selected, the microcontroller can be programmed to enable all added-

value programming or services that are specially related to the selected content-specific category. For example, if the user activates a Sports content-specific mode, the microcontroller, in addition to allowing only sports programming or schedule information related to sports programming to be displayed, will proactively seek out and enable all sports related added-value services, such as related trivia or video games, up-to-date scores while a game is in progress, team schedules, replays of prior games of the selected teams or players, ticket or souvenir purchasing, etc. Thus, the information available from the programming or service can be integrated into the environment of the electronic program guide. Rather than simply passing control to another service as described above, in this manner the electronic program guide would function as a system integrator or interface to combine the available added-value information into a package within the electronic guide environment, thus essentially creating a series of modular electronic program applications corresponding to a variety of available content-specific categories.

Alten discloses the electronic program guide functions as a system integrator (recommended program indicator) or interface to combine the available added-value information into a package within the electronic guide environment, thus essentially creating a series of modular electronic program applications corresponding to a variety of available content-specific categories (preferred program indicators). Examiner maintains Alten reads on recommended program indicator and preferred program indicator.

**Applicant Argues:**

Applicant states in the third paragraph of page 11 that "Alten Figure 8, for example, shows a favorite channel screen. Notice that only favorite channels are listed. Programs are not listed. Applicants claim 1 requires retrieving a list of recommended program indicators and not a list of favorite channels. Thus claim 1 is distinguished over Alten."

**Examiner Responds:**

Examiner is not persuaded. The following disclosure in Alten's abstract explains that programs are listed, not channels.

**Abstract Text (1):**

An electronic program schedule system which includes a receiver for receiving broadcast,

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satellite or cablecast television programs for a plurality of television channels and a tuner for tuning a television receiver to a selected one of the plurality of channels. A data processor receives and stores in a memory television program schedule information for a plurality of television programs to appear on the plurality of television channels. A user control apparatus, such as a remote controller, is utilized by a viewer to choose user control commands and transmit signals in response to the data processor which receives the signals in response to user control commands. A television receiver is used to display the television programs and television program schedule information. A video display generator receives video control commands from the data processor and program schedule information from the memory and displays a portion of the program schedule information in overlaying relationship with a television program appearing on a television channel in at least one mode of operation of the television programming guide. The data processor controls the video display generator with video control commands, issued in response to the user control commands, to display program schedule information for any chosen one of the plurality of television programs in overlaying relationship with at least one television program then appearing on any chosen one of the plurality of channels on the television receiver.

**Applicant Argues:**

Applicant states in the fourth paragraph of page 11 “Claim 1 also recites ‘generating a list of displayable program indicators, wherein the list of displayable program indicators includes program indicators in the list of recommended program indicators.’ Alten does not teach or disclose this limitation. For example, Alten’s favorite channel 71 as referred to in the Office Action, cannot be used to generate a list of displayable program indicators as claimed.”

**Examiner Responds:**

Examiner is not persuaded. It is worthwhile to consider above limitation in order to obtain a clear understanding of the gist of the claim. The above limitation merely states that the list of recommended program indicators is capable of being displayed because examiner maintains recommended program indicators are obviously program indicators. There are a plurality of disclosures by Alten that lists of program indicators can be displayed.

Alten discloses in column 10, lines 21-45, the following:

The MODE key 38 takes the user through various layers of the electronic program schedule system 10 and generally allows the user to return to a previous screen when he is in a submenu. The up/down direction arrow keys 37A allow a user to navigate through the different TV program channels when the program schedule system is in a FLIP or BROWSE mode, as will be fully described below, and also allow the user to navigate through highlighted bars displayed on the TV screen when in a MENU mode. The left/right direction arrow keys 37B allow the user to navigate through selected time periods when the program schedule system is in the BROWSE mode, as will also be described below. They further allow the user to navigate across subject-matter categories while in the "categories" submenu of the MENU mode, as well as to navigate across time periods when the program schedule system is in a pay-per-view ordering mode and, in general, navigate in left or right directions to select various icons and other objects. The information, or "i," key 39 allows the user to view supplemental program and other information during the various modes of the program schedule system. The ENTER 35 key fulfills and inputs a command once the user has made a selection from the remote controller keys. The function and operation of these keys will be made more apparent in the detailed discussion of the FLIP, BROWSE and MENU modes below.

Alten discloses per the above that a user is able to navigate through various layers of the electronic program schedule system, the user always being able to return to a previous screen when he is in a submenu. Examiner maintains that Alten discloses a list of displayable program indicators.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

February 22, 2005



SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
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